Remarks

This Amendment is submitted in response to the final office action mailed July 8, 2005, in connection with the above-identified application (hereinafter the "Office Action"). The Office Action provided a three-month shortened statutory period in which to respond, ending on September 8, 2005. Additionally, this Amendment is being submitted within two months from the mailing of the final office action. Accordingly, this Amendment is timely submitted.

Claims 1-6, 8, 12-33 are currently pending. Applicants respectfully request that claims 2, 3, 8, and 27 to 31 be cancelled without prejudice. Applicants reserve the right to prosecute these claims in a later to be filed application. Applicants also respectfully request entry of new claims 34 through 37. Moreover, Applicants respectfully request entry of the amendments to claims 1, 4 and 6. Applicants respectfully submit that the new claims and amendments to pending claims do not introduce any new matter. Thus, claims 1, 4 through 6, and 32 through 37 are currently pending.

Rejection under 35 U.S.C. § 112

Claim 33 is rejected under 35 U.S.C. § 112 as being indefinite; "it is unclear as to what applicant intends to convey by 'polyvinyl alcohol has a degree of hydrolysis greater than 70%." Applicants respectfully submit that this is definite to one of ordinary skill in the art. Polyvinyl alcohol is produced by the hydrolysis of polyvinyl acetate. The degree of hydrolysis of polyvinyl alcohol refers to varying levels of hydrolysis (or saponification).

Rejection under 35 U.S.C. § 103(a)

Claims 1-6,8,12-26 and 32-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Preparation of aqueous polymeric nanodispersions by a reversible salting-out process: influence of process parameters on particle size* to Allémann et al. (hereinafter "*Allémann*") and U.S. Patent No. 4,343,789 to Kawata (hereinafter "*Kawata*").

Applicants respectfully submit that this rejection is improper because a *prima facie* case of obviousness has not been established. The three elements of a *prima facie* case of obviousness are 1) some suggestion or motivation to modify the reference or combine the teachings; 2) a reasonable expectation of success and 3) the prior art references must teach or suggest all the claim limitations. It is respectfully submitted that not all of these elements have been established by *Allémann* in view of *Kawata*.

Allémann fails to disclose a preparation that incorporates an active ingredient. The Office Action points to page 233 in *Allémann* as teaching that nanospheres are for sustained release dosage forms and are therefore for water insoluble drugs.

Applicants respectfully submit that a careful reading of page 233 is required. First, *Allémann* specifically refers to an "injectable sustained release dosage form." An injection is different from an oral dosage form. Claim 1 specifically requires that the pharmaceutical composition be an oral dosage form not an injectable. Second, the preparations in Allemann would be suitable as a parenteral composition if poly(dl-lactic acid) were also included. The pharmaceutical compositions of the present invention do not necessarily require the use of poly(dl-lactic acid), thus distinguishing them. Third assuming *arguendo* that *Allémann* discloses an active agent, nowhere in *Allémann* is a poorly water soluble active agent disclosed. Furthermore, Applicants respectfully submit that the use of an injectable sustained release dosage form does not necessarily mean that the active being delivered is poorly water soluble (*See*, e .g., *Morella*, *infra*., which discloses a highly water soluble active in a sustained release formulation). Thus, not each and every element is disclosed in *Allémann*, and *Kawata* fails to cure these deficiencies.

Kawata teaches a four component sustained release pharmaceutical composition that contains a medical material, polyethylene oxide, a 1st component and a 2nd component. This pharmaceutical composition exists as a fine powder with no aqueous formulation base. There is no reason suggestion or motivation to combine *Allémann* with *Kawata*. The former is a formulation containing a nanosuspension dispersed in an aqueous formulation base whereas the latter concerns a solid pharmaceutical dosage form.

Furthermore, expanding on the Examiner's reference to page 233 of *Allémann*, if *Allémann* refers to an injectable formulation, then it is even more unlikely to consult *Kawata* since *Kawata* teaches an oral formulation. One would likely combine the references since they are teaching different routes of administration. Because the nature of the formulations are different, one being a nanosuspension in an aqueous formulation base, and the other being an encapsulated powder, there is no reasonable expectation of success that one of ordinary skill in the art would obtain the present invention as defined by Claim 1.

Thus, for the above reasons, Applicants respectfully submit that the prima facie elements of obviousness have not been shown, and the rejection should be withdrawn.

Claims 1-6, 9, 12-26, and 32-33 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawata* by itself or in view of U.S. Patent No. 5,133,908 to Stainmesse (hereinafter "*Stainmesse*") in further combination with U.S. Patent No. 5,378,474 to Morella (hereinafter "*Morella*").

As discussed above, *Kawata* is deficient since it teaches a pharmaceutical formulation that lacks an aqueous formulation base. Furthermore, *Kawata* fails to teach the use of polyvinyl

alcohol. *Stainmesse* also fails to disclose the use of polyvinyl alcohol in the aqueous formulation base.

Morella is relied upon for teaching the use of polyethylene glycol or polyvinyl alcohol in sustained enteric release systems. *Morella* teaches the coating of an active ingredient of *high solubility*. *See*, Column 1, lines 21-24 of *Morella*. Thus, there is no motivation to combine *Kawata* with *Morella* since the former teaches poorly water soluble active in a pharmaceutical formulation, and the latter teaches a highly water soluble actives in a pharmaceutical formulation. Varying degrees of solubility change a formulation strategy. Furthermore, as with *Kawata*, *Morella* teaches a solid oral dosage form that lacks an aqueous formulation base component. In view of this, there is no prima facie case of obviousness presented by the combination of *Kawata*, *Stainmesse* and *Morella*.

Thus, in view of the foregoing arguments, Applicants respectfully request reconsideration of the present application. If a telephone interview would be of assistance in advancing the prosecution of this application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

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Date: July 26, 2005